

Remarks

Examiner Fenn Mathew is thanked for the thorough Office Action.

In the Claims

The appendix contains a “marked up version “ of the amended claims.

Canceled claims

Claims 27 to 36, 37 to 42, and 43 to 48, are canceled subject to the condition that the claims can be made the subject matter of subsequent patent application(s) claiming priority from the instant patent application.

Added claims

New claims 49 to 63 are added. For all new added claims, for support see specification p. 6, lines 5-6. See spec. pp. 9 to 16; p. 14, lines 19-23. See figs 2F, 2D and 2E.

For claims 51, 54 and 63, for support see spec. p. 13, lines 26 to 31; See fig 2A. The claimed dimensions apply to figure 2F since figures 2A, 2F and 9A are members of the “first configuration option”. See spec. p. 9, lines 30 to p. 10, line 3.

For claims 52, 58 and 62, for support see spec. p. 11, lines 27 to 29.

For claim 59, for support see claim 17, see spec p. 11, lines 16 and 17.

For claim 61, for support see spec p. 13, lines 22 and 23.

No new matter is added.

The newly added claims read on the elected species as discussed below.

No fee needed for the added claims

No fees are required for the added claims as more claims were canceled than added. (Total of 22 canceled claims of which 2 claims are parent claims. Total 16 added claim, of which 2 are parent claims.)

ELECTION/RESTRICTIONS

Provisional election with traverse

Applicant provisionally elects to be examined the invention described by the examiner as the species at least shown in figure 2F. This election is made with traverse of the requirement under 37 C.F.R. 1.143 for the reasons given in the following paragraphs.

The following claims read on the species shown in figure 2F: Claim 1, 2, 3, 4, 5, 6, 9, 10, 12, 13, 15, 21, 23 and 25; and new claims 49 - 63.

All the newly added claims encompass the subject matter of the elected species.

Claim 1 is generic

Claim 1 is generic to at least the species shown in

figs 1A thru 7D, including elected species 2F. The Office Action dated

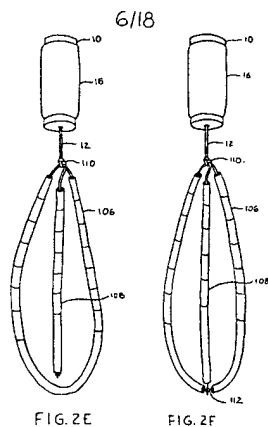
12/13/02 page, 3 argues that no claim is generic. However, this response canceled claims 27 to 48. Claim 1 is generic and many of the dependent claims to claim 1 are generic to many of the species and sub-species.

Patent applications can include more than one species

Under 37 CFR 1.141, applicant is allowed to claim more than one species of an invention as provided below:

37 CFR 1.141 Different inventions in one national application.

(a) Two or more independent and distinct inventions may not be claimed in one national application, except that more than one species of an invention, not to exceed a reasonable number, may be



specifically claimed in different claims in one national application, provided the application also includes an allowable claim generic to all the claimed species and all the claims to species in excess of one are written in dependent form (§ 1.75) or otherwise include all the limitations of the generic claim.

Furthermore, two different subcombinations usable with each other may each be a species of some common generic invention. See MPEP 806.04(b) below.

806.04(b) Species May Be Related Inventions

Species, while usually independent, may be related under the particular disclosure. Where inventions as disclosed and claimed are both (A) species under a claimed genus and (B) related, then the question of restriction must be determined by both the practice applicable to election of species and the practice applicable to other types of restrictions such as those covered in MPEP § 806.05 - § 806.05(i). If restriction is improper under either practice, it should not be required.

For example, two different subcombinations usable with each other may each be a species of some common generic invention. In *Ex parte Healy*, 1898 C.D. 157, 84 O.G. 1281 (Comm'r Pat. 1898), a clamp for a handle bar stem and a specifically different clamp for a seat post both usable together on a bicycle were claimed. In his decision, the Commissioner considered both the restriction practice under election of species and the practice applicable to restriction between combination and subcombinations.

803 Restriction - When Proper

Under the statute an application may properly be required to be restricted to one of two or more claimed inventions only if they are able to support separate pat-ents and they are either independent (MPEP § 806.04 - § 806.04(i)) or distinct (MPEP § 806.05 - § 806.05(i)).

If the search and examination of an entire application can be made without serious burden, the examiner must examine it on the merits, even though it includes claims to independent or distinct inventions.

The MPEP section 803 states:

CRITERIA FOR RESTRICTION BETWEEN PATENTABLY DISTINCT INVENTIONS

There are two criteria for a proper requirement for restriction between patentably distinct inventions:

(A) The inventions must be independent (see MPEP § 802.01, § 806.04, § 808.01) or distinct as claimed (see MPEP § 806.05 - § 806.05(i)); and

(B) There must be a serious burden on the examiner if restriction is required (see MPEP § 803.02, § 806.04(a) - § 806.04(i), § 808.01(a), and § 808.02).

GUIDELINES

Examiners must provide reasons and/or examples to support conclusions, but need not cite documents to support the restriction requirement in most cases.

Where plural inventions are capable of being viewed as related in two ways, both applicable criteria for distinctness must be demonstrated to support a restriction requirement.

If there is an express admission that the claimed inventions are obvious over each other within the meaning of 35 U.S.C. 103, restriction should not be required. In re Lee, 199 USPQ 108 (Comm'r Pat. 1978).

For purposes of the initial requirement, a serious burden on the examiner may be prima facie shown if the examiner shows by appropriate explanation of separate classification, or separate status in the art, or a different field of search as defined in MPEP § 808.02. That prima facie showing may be rebutted by appropriate showings or evidence by the applicant. Insofar as the criteria for restriction practice relating to Markush-type claims is concerned, the criteria is set forth in MPEP § 803.02. Insofar as the criteria for restriction or election practice relating to claims to genus-species, see MPEP § 806.04(a) - § 806.04(i) and § 808.01(a).

The applicant's claimed species do not represent a serious burden since they are in same class for search.

The examiner has not made a showing under MPEP 803 that this is “**a serious burden**”. It appears that all the species in the non-canceled claims are searchable in the same class/subclass as the elected species. For example see applicant's IDS report. See Patent Classification, Class 482, EXERCISE DEVICES, Sub class 81 SKIPPING and sub class 82 Handheld jump rope. It appears that all the species in the non-canceled claims are searchable in the same classifications and co-extensive fields of search as the elected species.

Alternative Argument - Application requests restriction requirement to allow examination of "first configuration option"

In an alternative argument, the examiner is respectfully requested to reconsider the restriction requirement and all the species shown in applicant's "first configuration option" (See spec. p. 9 lines 30 to p. Line 3.)

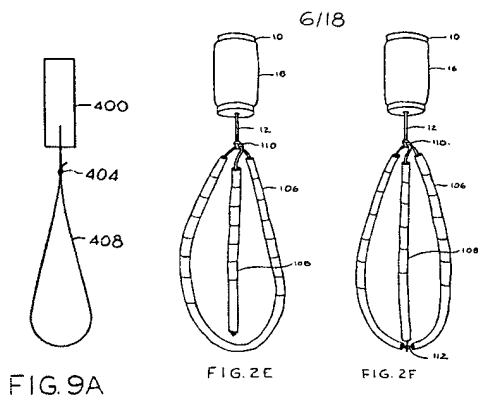


FIG. 9A shows a general view of the first configuration option where the loop forming device 404 is located outside of the handle 400 and the loop is comprise of a first element 408.

FIGS. 1A, 1F, 1G, 1H, 2A, 2B, 2C, 2D, 2E, 2F, 3A, 3B, 3C, 3D, and 6D show embodiments of the first configuration option, where the loop forming device (e.g., 14) is located outside of the handle. See spec. p. 9, L 30 to p. 10, L 3.

The invention of the "first configuration option" could be searched without undue burden since the species have a common configuration and fall into co-extensive fields of search as the elected species. For example see applicant's IDS report. See Patent Classification, Class 482, EXERCISE DEVICES, Sub class 81 SKIPPING and sub class 82 HANDHELD JUMP ROPE. It appears that all the species in the "first configuration option" are searchable in the same classifications and co-extensive fields of search as the elected species.

The examiner is respectfully requested to reconsider the requirement for restriction given in the office action.

Cancellation Of Non-Elected Claims Be Held In Abeyance

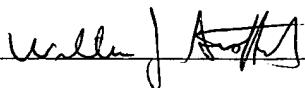
It is requested that the cancellation of the non-elected claims be held in abeyance until the prosecution of the elected species is completed.

CONCLUSION

In conclusion, withdrawal of the restriction requirement is respectfully requested. Allowance of all claims is requested. Issuance of the application is requested.

It is requested that the Examiner telephone the undersigned attorney at (215) 670-2455 should there be anyway that we could help to place this application in condition for allowance.

Respectfully submitted,

 1/13/03

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